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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,334	07/06/2001	Peter K. Malkin	YOR9-2001-0313US1 (8728-5)	6308
7590 05/06/2004 F. CHAU & ASSOCIATES, LLP Suite 501 1900 Hempstead Turnpike East Meadow, NY 11554			EXAMINER HARLE, JENNIFER I	
			ART UNIT 3627	PAPER NUMBER

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,334

Applicant(s)

MALKIN ET AL.

Examiner

Jennifer I. Harle

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-20 are pending. Claims 1-20 are rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, and 5-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Herrod, et al. (6,405,049 B1).

As per claim 1, Herrod discloses a method for providing product information (Figs. 6-8) comprising the steps of:

Establishing a local reference frame which describes a space including a product identifies and a portable display device (Figs. 5-8);

Receiving a request for product information corresponding to the product identifier from the portable display device (Fig. 8a; col. 11);

Determining a position of the portable display device in relation to the local reference frame (Figs. 5-8);

Providing the product information via the portable display device according to the position of the portable display device (Figs. 5-8; cols. 10-12).

As per claim 2, Herrod discloses receiving an order for a product corresponding to the product identifier from the portable display device (col. 13).

As per claim 5, Herrod discloses the step of providing a menu for distinguishing a plurality of products in the space via the portable display device (Figs. 5-8; col. 11).

As per claim 6, Herrod discloses theof redirecting a user toward an alternative product using the portable display device (Figs. 5-8; col. 11).

As per claim 7, Herr discloses determining the orientation of the portable display device and utilizing that orientation to select options to present to the consumer based upon the location of the product being looked for and another proximate object on the basis of the portable display device (Figs. 5-8; col. 11).

As per claims 8 and 9, Herrod discloses the user of active beacons in the use of determining position by comparing strength (col. 10).

As per claim10-12, Herrod discloses the use of a geometric positioning system, i.e. using passive environmental markings and determining position relative to an angle between at least two environmental markings (cols. 10-11).

As per claim 13, Herrod discloses that the product information is retrieved from a database stored in the portable display device (Figs. 5-8; cols. 7-8 – the pda stores the information to obtain the product information short term and the links to upload it from the central databases).

As per claim 14, Herrod discloses that the local reference frame is established relative to the portable display device and moves with the portable display device (Figs. 5-8 – You are Here; cols. 10-12).

System claims 15-18 are rejected for the same reasons set forth above in the method claims above. The means for language has been given its broadest reasonable interpretation.

As per claim 19, Herrod discloses a wireless communications link between the portable display device and a database of product information (Figs. 2-5; cols. 5-8).

The program storage device apparatus claim is rejected for the same reasons as the method claims set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herrod, et al. (6,405,049 B2).

Herrod discloses as set forth above. Herrod additionally discloses that there are numerous applications and advantages are provided by the system shown in Figs. 1, 2a and 2B, particularly the advantages of a hand-held terminal such as portability, ease of use and suitability for mobile use in the application of auctions (col. 7). Moreover, auction are also a retail environment like a grocery store and thus the same applications or local frame references would apply, e.g. car auctions, and auctions of goods that are displayed for view (Christie's and Bankruptcy Auctions of goods and merchandise). However, Herrod does not disclose the step of receiving a bid where the bid corresponds to a product identifier from the portable display device. However, as Herrod's discloses that the product can be used in auctions it would have to accept a bid where the bid corresponds to a product identifier from the portable display device because otherwise there would be no way to link the bid to the product. It would have been

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obvious to one of ordinary skill in the art at the time of the invention to have utilized a bid with the system/method of Herrod because Herrod discloses that it can be used in such an environment and because it would facilitate the flow of people and exchange of merchandise, thus creating more sales and facilitating the speed of transactions, just like any other retail environment.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herrod, et al. (6,405,049 B2) in view of Stevens (US 2002/0087392 A1).

Herrod discloses as set forth above. Herrod additionally discloses that portable terminals include a wide range of applications including word processing, etc. (col. 1). Herrod further discloses that the portable terminal can contain personal ID information and can include customer's buying patterns and preferences, which could include a shopping list to assist in the targeting of product advertisements (Fig.8 and cols. 10-11). However, Herrod does not specifically disclose a corresponding a product identifier to a shopping list. Stevens discloses corresponding a product identifier to a shopping list as it is being created a "to-do-list" on a portable terminal in the shopping environment for price verification and list maintenance for the customer so that he/she know at all times what has been spent in the store ([0014], [0053]). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included the shopping list of Stevens in the system/method of Herrod for the reasons set forth above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Siegel, et al. (2002/00/2931) discloses a method and system for performing electronic retailing utilizing handheld devices and UPC symbols in specific locations.

Kindber, et al. (2002/0184332 A1) discloses a physical registration method and system for resources that utilizes a portable device that registers entities, e.g. paintings, that can then be used by users to define a resource address for physical registration.

Lev, et al. (2002/0102966 A1) discloses an object identification method for portable devices that allows a user to locate an object, find out information about it, and buy it.

LaBrie, et al. (2002/0055872 A1) discloses a user services and information management system and method that utilizes pdas.

Blight, et al. (2002/0194498 A1) discloses a mobile communication system for location aware service.

Blight, et al. (2002/0184331 A1) discloses a resource location through location history utilizing pdas.

Hind, et al. (2002/0174025 A1) discloses a method and system for providing targeted advertising and personalized customer services in the retail environment specific to location on handheld devices.

Suila, et al. (2002/0194303 A1) discloses a portable shopping assistant.

In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, and because "the continual, chief complaint of inventors and their lawyers: that patent examiners are abysmal communicators, both orally and in writing,"¹ the Examiner has made every effort to clarify his position regarding claim interpretation and

¹ Sabra Chartrand, *A Bid to Overcome Patent Backlogs*, 152 N.Y. Times C2 (Sept. 23, 2002).

any rejections or objections in this application. Furthermore, the Examiner has provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant(s) disagree with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,² the Examiner respectfully requests Applicant(s) *in their next response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. Failure by Applicant(s) *in their next response* to traverse the Examiner's positions and provide appropriate arguments in support thereof will be considered an admission by Applicant(s) of the factual determinations and legal conclusion not expressly traversed.³ By addressing these issues now, matters where the Examiner and Applicant(s) agree can be eliminated allowing the Examiner and Applicant(s) to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:30 am to 5:00 pm,.

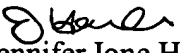
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703.308.5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

² E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

³ See also MPEP §714.02, 37 CFR §1.111(b), and 37 CFR §1.104(c)(3).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer Ione Harle
May 3, 2004